

REMARKS

The Examiner is thanked for the thorough review and examination of this application. The Office Action, however, tentatively rejected all claims 1-20. Claim 1 is amended, and the limitation in claim 4 and 5 are added into claim 1. As amended, claim1 patently defines over the cited art, and the rejections should be withdrawn.

Discussion of Rejections under 35 USC 102

Claims 1-6, 8-13, 19 and 20 were tentatively rejected under 35 U.S.C. 102(e) as allegedly anticipated by Ioune et al. (US 2003/0020152A1).

Independent claim 1 defines:

1. A plasma display, comprising:
a base plate;
a back cover engaged with the base plate to form a space;
a first circuit board disposed in the space and mounted on the base plate;
a first electronic element disposed on the first circuit board;
a first thermal conductive device disposed between the first electronic element and the back cover and mounted on the first electronic element, wherein the first thermal conductive device comprises a thermal conductive spring element having at least one spring leg extending toward the back cover and at least one contact plate connected to the spring leg and abutting the back cover.

(*Emphasis added*). Claim 1 patently defines over the cited art for at least the reason that the cited art fails to disclose at least the features emphasized above.

Among other features and limitations, claim 1 defines a first thermal conductive device disposed between the first electronic element and the back cover and mounted on the first electronic element. The first thermal conductive device comprises a thermal conductive spring element, which has at least one spring leg extending toward the back cover and at least one contact plate connected to the spring leg and abutting the back cover.

In contrast, Ioune discloses a thermal conductive device 68 disposed between driver IC chips 58 and chassis 13. However, the thermal conductive device 68 is only a conductive resin sheet without the spring leg and contact plate in the application. The spring leg and contact plate of the claimed embodiment are not disclosed in Ioune. For at least this reason, the structure of the embodiments defined in claim 1 are different from that of Ioune. Accordingly, the rejection under 35 USC 102 should be withdrawn.

The rejections of all remaining claims should be withdrawn based on the dependency of these claims on claim 1.

Discussion of Rejections under 35 USC 103

Claims 7, 14-17, and 18 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Inoue in view of Nguyen and/or Tani. Applicant respectfully traverses the rejections as failing to identify a proper basis for combining the cited references. In combining Inoue with Nguyen, the Office Action stated only that the combination would have been obvious “to make use of its excellent thermal and reliability performance.” (Office Action, page 5). This alleged motivation is clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must

be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive a plasma display, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

For at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, those rejections should be withdrawn.


CONCLUSION

For at least the reasons described above, all claims are now in condition for allowance.

Should Examiner feel that further discussion of the application and the Amendment is conducive to prosecution and allowance thereof, please do not hesitate to contact the undersigned at the address and telephone listed below.

No fee is believed to be due in connection with this Amendment and Response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

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